

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Roger PELLENC

Group Art Unit: 2838

Appln. No. : 10/580,155

Examiner: Jue Zhang

Filed : May 19, 2006

Confirmation No.: 8057

For : POWER AUTONOMOUS PORTABLE ELECTRIC TOOL SET

## RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents  
U.S. Patent and Trademark Office  
Customer Service Window, Mail Stop Amendment  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

In response to the Examiner's election of species requirement of April 30, 2009, the time set for response being extended two (2) months to July 30, 2009, Applicant hereby elects with traverse, Species 2, which is directed to Figures 10 - 12. Applicant submits that dependent claims 107, 108, 110 - 134 and 139 - 141 are readable on the elected species, and at least claims 84 - 106, 109, 135 - 138, 142 and 143 are generic. Thus, all pending claims 84 - 143 are readable on the elected species. The above election is made with traverse for the reasons set herein below.

In the election of species requirement of September 17, 2008, the Examiner indicated that all claims (84 – 143) were subject to election under 35 U.S.C. § 121. The Examiner has required an election of one of the following species:

Species 1 – Figures 3 – 9; and

Species 2 – Figures 10 – 12.

The Examiner asserts that the species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. Additionally, the Examiner states that these species are not obvious variants of each other based on the current record.

Applicant has elected Species 2 directed to Figures 10 – 12 with traverse. Moreover, Applicant acknowledges that, upon allowance of a generic claim, the other species will be rejoined and examined on their merits. The Examiner has identified claim 1 as generic. Applicant notes that claim 1 has been previously canceled, and thus, assumes the Examiner intended to indicate that at least claim 84 is generic.

Applicant notes that claims 107, 108, 110 – 134 and 139 – 141 are readable on the elected species, and at least claims 84 – 106, 109, 135 – 138, 142 and 143 are generic. As such, Applicant submits that all of the claims read on the species shown in Figures 10 – 12. For example, Applicant notes that Figures 10 and 11 describe a detailed feature of Figure 9 (see figure descriptions of Figures 9 – 11). Thus, Figures 10 and 11 are not a species of Figure 9. Furthermore, Figure 12 describes a charging system for the device of Figures 1 – 11, and not a system related only to Figures 10 and 11. As such, Applicant respectfully submits that, upon election of Species 2, the Examiner should examine the claims of species 2 (i.e., claims 107, 108, 110 – 134 and 139 – 141) and the generic claims (i.e., claims 84 – 106, 109, 135 – 138, 142 and 143).

Applicant also elects Species 2 with traverse for the following additional reasons. Initially, Applicant respectfully submits that the restriction requirement is *per se* improper. Applicant notes that the instant application is a U.S. National Stage Application filed under 35 U.S.C. § 371. As such, in accordance with MPEP § 1893.03(d), Applicant respectfully submits

that the proper test for requiring a restriction is unity of invention under 37 C.F.R. § 1.475. Thus, Applicant respectfully submits that the election of species requirement is *per se* improper, as the Examiner has not addressed unity of invention.

Furthermore, assuming *arguendo* that the application was filed under 35 U.S.C. § 111, (which it was not), Applicant submits that the election of species requirement is improper. Applicant respectfully submits that the Examiner has not set forth "an appropriate explanation" as to the existence of a "serious burden" if the election requirement were not required, as set forth in M.P.E.P. § 803. The Examiner states that there is an "examination and search burden" for these patentably distinct species due to their mutually exclusive characteristics. More specifically, the Examiner states "[t]he species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph."

Initially, Applicant notes that the Examiner has not asserted a "serious burden" if the election of species requirement were not required. That is, the Examiner identifies an "examination and search burden" if the election of species requirement were not required. Thus, Applicant submits that the Examiner has not set forth a proper election of species requirement.

Moreover, Applicant respectfully submits the conclusory statements of "examination and search burden" fail to comply with the requirements of M.P.E.P. § 803 of "an appropriate explanation" be advanced by the Examiner as to the existence of a "serious burden" if the election of species requirement were not required. In this regard, the Examiner has not identified any features or burdens specific to the subject matter of the present invention or identified any

manner by which a search for the subject matter of the different species would not overlap.

Thus, Applicant submits the conclusory statements of the examination and search burden cannot be considered an appropriate explanation under MPEP § 803.

Further, MPEP § 808.02 provides that the Examiner, “in order to establish reasons for insisting upon election of species, must explain why there would be a serious burden on the Examiner,” and that the Examiner “must show by appropriate explanation one of the following: . . . (A) Separate classification thereof . . . (B) A separate status in the art when they are classifiable together . . . [or] (C) A different field of search.” While the Examiner has included some of these reasons (A) – (C) in their reason for election of species, Applicant reiterates that these are conclusion and not appropriate explanations based upon the specifics of the subject matter of the invention at issue. Further, Applicant submits no appropriate explanation of serious burden has been presented in support of the Examiner’s election of species requirement. Moreover, Applicant notes that the Examiner withdrew the previous Restriction Requirement dated September 17, 2008 because the Examiner found Applicant’s previous arguments as to no existence of a serious burden for searching persuasive.

Accordingly, should the Examiner wish to maintain the election of species requirement, Applicant respectfully requests the Examiner provide detailed reasons or explanations in support of the election of species based upon the specifics of this application. Otherwise, the election of species requirement should be withdrawn and all claims 84 - 143 should be examined.

It is Applicant’s position that the search for the combination of features recited in the claims of the above-noted species, if not totally co-extensive, would appear to have a very substantial degree of overlap. Because the search for each group of invention is substantially the


same, Applicant submits that no undue or serious burden would be presented in concurrently examining Species 1 and Species 2.

Thus, for the above-noted reasons, and consistent with the office policy set forth above in M.P.E.P. §§ 803 and 808.02, Applicant respectfully requests that the Examiner reconsider and withdraw the election of species requirement in this application.

For all of the above reasons, the Examiner's election of species requirement is believed to be improper. Nevertheless, Applicant has elected, with traverse, Species 2, which is directed to Figures 10 - 12 and claims 84 - 143, which are readable on the elected species, in the event that the Examiner chooses not to reconsider and withdraw the restriction requirement.

Should there be any questions or comments, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,  
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